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09/866,652	05/30/2001	Tommaso Innocenti		5784

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Peter Gibson
6316 Greenspring Avenue, #307
Baltimore, MD 21209

EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,652

Applicant(s)

INNOCENTI, TOMMASO

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 and its dependent Claims recite the phrases “providing the option of provision of a model...” and “providing the option of provision of a sample...” These phrases do not make clear if a model or sample are ever provided and are read as not being limitations. Additionally, the optional provision does not relate to the rest of the claim language. No use of the quality indications is made in the execution of the auction. An inventive feature such as bid calculation based on indicated quality would perhaps relate these limitations to the rest of the Claim.

Claims 53, 54, 57, 59, 60 and 63 recite the qualifier “may choose”, which is unclear as to whether a choice is made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-41, 43, 46-49, 52-54, 56-57, 59-60 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view of *Moshal et al.*

Concerning Claim 40, *Lerner* discloses the invention substantially as claimed including in a business method intended to facilitate flexible terms commodities trading in an exchange (Para. 100 and Title), the steps of:

providing, upon a web site accessible upon the world wide web (Fig. 4D), information of a particular commodity (Fig. 4D, category of sugar) weight (Fig 4D. "14000mt"), price (SBH1 + 12 points), and specific commodity category dependent quality characteristics (Fig. 4D, "bulk world raws") desired by a prospective buyer (trader; See also para. 99) in completion of a submission for initiating an open bid;

providing the option of provision of a model of a particular commodity desired for purposes of indicating the quality desired by a prospective buyer (Abstract; para. 62);

providing, upon a web site accessible upon the world wide web (Fig. 4D), information of a particular commodity (Fig. 4D, category of sugar) weight (Fig 4D. "14,000mt"), price (SBH1 + 12 points), and specific commodity category dependent quality characteristics (Fig. 4D, "bulk world raws") offered by a prospective seller (trader; see also para.99) in completion of a submission for initiating an open offer;

providing the option of provision of a sample of a particular commodity desired for purposes of indicating the quality desired by a prospective seller (Abstract; para. 62);

posting upon said web site a listing for a specified lot of a particular commodity in accordance with a completed proposal submission detailing a plurality of terms including weight, price, quality characteristics, delivery and payment comprising an open offer of said specified lot when initiated by a prospective seller and comprising an open bid of said specified lot when initiated by a prospective buyer (Fig. 4E, element 454);

scheduling an auction of said specified lot by posting a plurality of schedule dates including but not restricted to commencement and conclusion dates between which responses to said listing will be received (paragraphs 117, 121);

posting upon said web site, in association with said listing, counter bids received in response to an open offer and counter offers received in response to an open bid which vary in any of the terms included in said plurality of terms detailed in said listing (paras. 102-107; Fig. 4H);

posting upon said web site, in association with said listing, any offer indications by said prospective seller in response to posted counterbids and any bid indications by said prospective buyer in response to posted counter offers signifying a modification of at least one term in said listing (paras. 102-107);

indicating upon said web site, in association with said listing, the matching in all said terms between any offer and any bid both concerned with said specified lot (para. 108).

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Lerner does not specifically disclose the limitation of auction format specification. *Moshal* discloses auction format specification for use by traders (bidders and sellers) in a trading exchange at Fig. 12; paras. 232-234, and paras. 92-99, at least. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the exchange of *Lerner* with the auction format specification disclosed by *Moshal* because this would have obtained the benefits to an exchange specifically set out by *Moshal* at paras. 38-39 and quoted below (particulars benefits are bolded):

An embodiment of the invention includes a system to power exchanges and marketplaces over networks such as the Internet, by providing software and support that allow dynamic pricing of goods and services. In contrast to previous systems that provide static pricing techniques, embodiments of the invention provide dynamic pricing to allow real-time adjustment of prices for purpose of capturing excess value, conducting price discovery, and creating exciting on-line marketplaces. Advantages provided include continuous trading, high transaction volume capacity, customizable information and transaction feedback. Furthermore, the system is data driven and highly configurable, enabling flexibility with high capacity.

There are many types of exchanges--forward, reverse, many-to-one and many-to-many. Examples of existing Internet exchanges include on-line auctions. These existing exchanges generally comprise inflexible and hard-coded software routines to emulate a certain auction type, such as the forward or reverse auction. In contrast, embodiments of the invention employ common characteristics between auction types. The common characteristics of these exchanges have been abstracted into a small subset of shared, common parameters. A system provided under an embodiment of the invention implements efficient trading software that generates exchanges and auctions based on the common parameters. By varying these parameters, multiple existing and new types of auction, exchanges and other price interactions may be created and conducted for multiple traders using a network such as the Internet.

With respect to Claim 41, *Moshal* discloses deposting at para. 206.

With respect to Claim 43, *Lerner* discloses a single website as "BigDogTrader.com" at Fig. 4J at least.

With respect to Claim 46, *Lerner* discloses registration access means at para. 94.

With respect to Claim 47, *Lerner* discloses fees at para. 32.

Concerning Claims 48 and 49, see the discussion of claims 46 and 47.

With respect to Claim 52, see *Lerner* at para. 32.

As to Claims 53, 54, 57, 59, 60 and 63, *Moshal* discloses the parameters and combinations recited in the Claims at paras. 146-180.

With respect to Claims 56 and 62, *Moshal* discloses price increase as a function of responses received at para. 97.

Claims 42 re rejected under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view of *Moshal et a* and further in view of *Microsoft Press Computer Dictionary*, hereinafter, *Dictionary*.

Concerning Claim 42, *Lerner* and *Moshal* disclose the invention substantially as claimed. See above. They do not specifically disclose that the buyer and seller websites are different. *Dictionary* discloses that individual websites on a common server are possible. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided different websites for buyers and sellers to specify auction types because this would have improved accessibility of the auction specification functionality.

Claims 44- 45, 50-51, 55, 58, 61 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view of *Moshal et al* and further in view of *Auction This*, already of record.

Concerning Claims 44 and 45, *Lerner* and *Moshal* disclose the invention substantially as claimed. See above. They do not specifically disclose that subscribers are notified of listings of interest by e-mail. *Auction This* discloses this feature at page 72, fifth paragraph and page 167, fourth paragraph. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the disclosures of *Lerner* and *Moshal* with the notification of *Auction This*, because this would bring to the attention of traders offers of interest and helped increase market activity and utility.

With respect to Claim 50, *Auction This* discloses a directory of categories at page 71, para. 4. Such a directory structure would have enhanced ease of search and utility of the method.

As to Claim 51, *Auction This* discloses listing subscriptions at page 166.

With respect to Claims 55, 58, 61 and 64, at page 85 *Auction This* discloses incremental bidding. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incrementally changed prices with respect to time because this would have “moved the auction along” as well as creating a feeling of urgency to participants which would increase auction profitability.

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view of *Moshal et al* and further in view of *Conklin et al*.

As to **Claim 71**, *Lerner* and *Moshal* disclose the invention substantially as claimed. See above. They do not disclose direct provision of a sample by a seller to a prospective buyer. *Conklin* discloses this feature at Col. 8, lines 17-24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used seller provided samples as disclosed by *Conklin* in combination with *Lerner* and *Moshal* because this would have allowed buyers to evaluate potential sellers as set forth by *Conklin* at the same site.

Claims 65 –70 and 72-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lerner* in view of *Moshal et al* and further in view of *Thomas et al*.

As to **Claims 65-70**, they are the buyer side of sample provision. See the discussion of Claims 71 and 72-76 below. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have for a buyer to provide a sample/model specifying the quality of commodities because this would have allowed the seller to know exactly the qualities desired.

As to **Claim 72**, *Lerner* suggests that the system receives a sample from a seller at para. 62 whereby the system provides access to laboratory testing.

Concerning Claim 73, *Lerner* and *Moshal* disclose the invention substantially as claimed. See above. They do not specifically disclose that laboratory test results are posted to a website. *Thomas* discloses this feature at para. 45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have posted laboratory results on a website because this would have allowed the buyer to identify a lot which most closely conformed to requirements, as set forth at the same cite.

With respect to Claim 74, it would have been obvious for the auction house to have been a conduit for the seller to buyer sample transfer because this would have allowed the contracting parties to maintain anonymity.

Regarding Claim 75, it would have been obvious to provide proportional divisions of a sample to prospective buyers for assessment because this would have assured comparable sub-samples and would have allowed bidders to adjust their bids based on equivalent quality of sub-samples. This is “comparing apples to apples” – literally.

Concerning Claim 76, see the discussion of claim 75.

Response to Arguments

Applicant's arguments filed February 6, 2004 have been fully considered but they are not persuasive.

Applicant is referred to MPEP 601.03 for information regarding correspondence address changes.

At pages 1-8 of the Response, Applicant exhaustively discusses elements of the prior office action.

Applicant's substantive argument occur at page 8 and also at pages 14-15, regarding rejections under 35 U.S.C. 112. Applicant fails clearly explain a relationship between the claim language and the passages cited from the prior office action. Applicant fails to address the Examiner's observation that “*No use of the quality indications is made in the execution of the auction. An inventive feature such as bid calculation based on indicated quality would perhaps relate these limitations to the rest of the Claim.*” Applicant fails to discuss his citation of the Examiner's phrasing to explain why his phrasing is clear.

At pages 14 and 15, Applicant argues the first 112 cause for rejection, Applicant's phrasing of "providing an option of provision..." in the Claims rejected under 35 U.S.C. 112, 2nd para. can also be interpreted as merely providing an interface button (option) usable to order a sample or model. Applicant's phrasing is vague as to what is actually provided. Reasonable consideration can be given to meanings in the specification, but the wording is so vague as to be ambiguous.

As to Applicant's argument regarding the rejection over "may choose" phrasing, in each recitation of Claim language at pages 16-17, the wording is vague. In each instance, a seller or buyer has an option of choosing certain parameters, but is not required to do so by the Claim limitations. If the buyer or seller exercises the option to not choose any parameters, the Claim language is irrelevant and not further limiting.

As to the 35 U.S.C.103 rejections, at section B, para. 2, appears to argue that *Lerner*, by not disclosing auction format specification, is precluded from disclosing an auction. The Examiner cited *Lerner* at paras. 117 and 121 as disclosing an auction which inherently has steps a. and b. at lines 14-17 of page 9 of the response.

At para. 3, Applicant fails to explain why the features disclosed by *Moshal* and providing motivation to combine are not beneficial. *Applicant* quotes *Moshal* as disclosing configurability, flexibility and high capacity. Applicant fails to explain why these are not beneficial and why they would not provide a reason for the combination of references.

At para. 4, Applicant appears to suggest that different buyer and seller web sites provide some feature or advantage; such a feature or advantage is unclaimed and unexplained. More web sites inherently improve accessibility. In response to applicant's argument that there is no

suggestion in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, different sites increase the number of access points to the system and enhance accessibility.

Applicant's arguments are fully addressed considering all grounds of rejection.

At para. 6, Applicant admits that provision of a sample is "common commerce practice" but fails to address why the Examiner's argument that such samples would help buyers evaluate potential sellers is incorrect.

As to Applicants argument at para. 7, that there is no suggestion in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As to Applicants argument at para. 8, that there is no suggestion in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As to Applicants argument at para. 9, that there is no suggestion in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As to Applicants argument at para. 10, that there is no suggestion in the prior art to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

At section D, paras. 7 and 9 and page 18, Applicant appears to try to disqualify the *Lerner* reference through his Declaration dated January 20, 2004. The evidence provided is insufficient to do so. Exhibit A is undated and unsigned and consists only of assertions. No evidenced is provided to show due diligence; such evidence might be provided, for example, as dated research notebooks, dated computer printouts or other detailed records showing daily

progress to reduction to practice. As to other paras. In Section D, they are restatements of points addressed above.

Arguments presented by Applicant at other locations of the response are repetitive and addressed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 305-7687

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CRK

crk

April 29, 2004



**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800**